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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/485,045	05/12/2000	SE-JIN LEE	JHU1440-1	1418

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05/30/2002

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EXAMINER

ANDRES, JANET L

ART UNIT

PAPER NUMBER

1646

DATE MAILED: 05/30/2002

17

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/485,045

Applicant(s)

LEE ET AL.

Examiner

Janet L. Andres

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 March 2002.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) 1 and 12-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 2 and 4-11 is/are allowed.
- 6) ☐ Claim(s) 3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **RESPONSE TO AMENDMENT**

1. Applicant's amendment filed 12 March 2002 is acknowledged. Claims 1-42 are pending in this application. Claims 1 and 12-42 are withdrawn from consideration as being drawn to a non-elected invention.

The text of those sections of Title 35, U.S. code, not included in this action can be found in a prior office action.

### ***Claim Rejections/Objections Withdrawn***

2. The objection to claim 3 is withdrawn in response to Applicant's amendment.
3. The rejection of claims 2-11 under 35 U.S.C. 112, first paragraph, as lacking written description and enablement commensurate with the scope of the claims is withdrawn in response to Applicant's amendment.
4. The rejection of claims 2-11 under 35 U.S.C. 112, second paragraph, as indefinite in the recitation of "GDF-16" is withdrawn in response to Applicant's amendment.

### ***New Grounds of Rejection***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(c) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily

published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim 3 is newly rejected under 35 U.S.C. 102(e) as being anticipated by 5916751 (Tabibzadeh et al., priority date August 1996).

The '751 patent teaches a polynucleotide sequence that contains a region of 303 nucleotides that is 92% identical to instant SEQ ID NO: 1. Complements to this sequence would also be complementary to SEQ ID NO: 1; section b) does not require that the complement be full length. Further, the sequence disclosed in the '751 patent contains regions of greater than 15 nucleotides that are identical to regions in instant SEQ ID NO: 1, thus anticipating the limitations of section c).

6. Claim 3 is newly rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for SEQ ID NO: 1, does not reasonably provide enablement for fragments that will detect sequences encoding GDF-16 by hybridization. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with this claim.

This claim encompasses fragments that identify GDF-16 by "hybridization". However, no hybridization conditions are specified. Under conditions of low enough stringency, any DNA will hybridize to any other. Thus without further guidance as to what hybridization conditions are required, one of skill in the art could not predictably identify and use fragments that would identify polynucleotides encoding SEQ ID NO: 2. Without further direction, therefore, it would require undue experimentation for the skilled artisan to make and use Applicant's invention as broadly claimed.

7. The rejection of claim 3 under 35 U.S.C. 112, second paragraph, as indefinite is maintained. Applicant's amendment altering "selectively hybridize" to "hybridization" does not overcome this rejection. As stated above, no particular conditions are required and one of skill in the art would not know what conditions Applicant intended the claim to encompass.

CLAIMS 2 AND 4-11 ARE ALLOWED. CLAIM 3 IS REJECTED.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet Andres, Ph.D., whose telephone number is (703) 305-0557. The examiner can normally be reached on Monday through Friday from 8:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, Ph.D., can be reached at (703) 308-6564. The fax phone number for this group is (703) 872-9306 or (703) 872-9307 for after final communications.

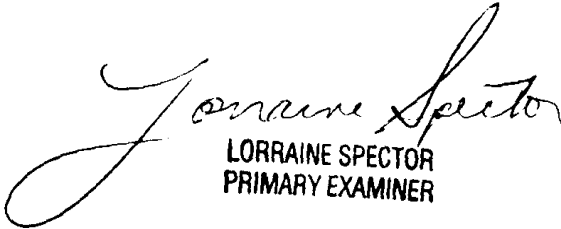
Communications via internet mail regarding this application, other than those under U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [yvonne.eyler@uspto.gov].

All Internet email communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35

U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark Office on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Janet Andres, Ph.D.  
May 29, 2002

  
LORRAINE SPECTOR  
PRIMARY EXAMINER